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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

00630.0320-US-D2

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 17 April 2006

Signature Jennifer Armstrong

Typed or printed name Jennifer Armstrong

Application Number

10/657623

Filed

8 September 2003

First Named Inventor

Martin Reed Bodley

Art Unit

2642

Examiner

Jack Chiang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

(See Notice of Appeal and Request for Pre-Appeal Review document)

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 29,555

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Michael B. Lasky  
Signature

Michael B. Lasky

Typed or printed name

952-253-4100

Telephone number

17 Apr 06  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒

\*Total of 1 forms are submitted.

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Serial No. 10/657623

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bodley et al.

Examiner: Jack Chiang

Serial No.: 10/657623

Group Art Unit: 2642

Filed: September 8, 2003

Docket No.: 00630.0320-US-D2

Title: HEADSET COMMUNICATION UNIT



CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on

17 April 2006

Jennifer Armstrong

Name

Jennifer Armstrong

Signature

**NOTICE OF APPEAL AND REQUEST FOR PRE APPEAL REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection in the above identified application. No amendments are being filed with this request.

**Basis for Pre-Appeal Conference**

Applicant requests review of the final rejection in the above identified application. The clear error is evident by the examiner's own statement of page 5 paragraph 2 of the final rejection (dated 26 Oct 05), wherein he states:

"...the claimed limitation is "the microphone arm...lies against the housing"

The examiner then refers to a Webster's dictionary for an understanding of the term "against". This is clear error. The settled case law is that the meaning of claim terms must *first* be derived from intrinsic evidence, the specification (which includes the drawings), before moving to extrinsic evidence, and even then, with great deference to the any intrinsic guidance found in the specification.

The prior art cited against claims 21 and 22 (Leifer) has been cited in the first action and was discuss in an in-person interview. Claim 22 was a proposal made during interview, which the examiner himself found allowable (subject to further review). It appears now, that the further review resulted in a change of position based on clear error, by using extrinsic evidence to interpret a word which is fully explained by intrinsic evidence.

In the present *claimed* invention, (claims 21, 22) , it is recited:

...the microphone arm can be moved between a first position in which its **inner surface lies up against** the housing...[emphasis added]

*It is the examiner's contention that Leifer supports a sec. 102b rejection because it too "lies up against the housing when "against" is interpreted in a particular (extrinsic) way". His contention is based on the use of extrinsic evidence from Webster's dictionary, but to use extrinsic evidence he must ignore to other, and more compelling pieces of evidence 1) massive intrinsic evidence (see below) and frankly 2) common sense. As to the common sense analysis, Figure 5 of Leifer must be compared to Figure 10 of this application. Clearly Figure 10 has the microphone arm against the housing. But Figure 5 of Leifer has the harm suspended in free space quite distant from a housing (if there is a housing in Leifer). Using the disclosure of Leifer and common sense, how can Leifer be a teaching of what it clearly does not teach. To get there, the examiner had to re-define the word against using an obtuse definition taken from extrinsic evidence and contrary to common sense.*

The present specification and drawings are replete with a definition which makes quite clear the meaning of word *against*.

1. See drawing figure 10 *showing* that the microphone arm is *against* the housing.
2. specification page 3, first paragraph recites  
... so that the microphone arm can be moved between a first position in which it lies up against the housing,...
3. Specification page 4, first full paragraph :  
so that the microphone arm, e.g. against a spring pressure, must be forced or moved away from the two stable positions, for example the **fully folded-in** and the fully folded-out position. [emphasis added]  
(See also page 16, first full paragraph)  
Illustrating, that in one embodiment, the term *against* means *fully folded in*
4. Specification page 14 second to last paragraph:  
The essential factor in this connection is that the shape is such that the communication unit is easily stored, and **such that the microphone arm 2 and the ear hook 6 can lie closely up against the housing.** [emphasis added]

5. Specification page 15, 1<sup>st</sup> paragraph:

Due to its shape and its short length, in this position the microphone arm **will lie closely up against the housing**, so that the communication unit will have the shape of a capsule or the like which occupies only very little space...  
[emphasis added]

Consequently, the use of extrinsic evidence to re-define explicitly stated meaning of *against*, is not only clear error as a matter of law, but ignores the common sense interpretation of the Leifer disclosure.

And although the clear error is *sufficient* to remove this rejection, Leifer is also insufficient to create a prima facie basis for rejection under section 102 or sec 103, because the teaching of Leifer is to **not** have the microphone boom lie *against* the housing. At best, Leifer has the boom swivel so that the unit can be hand held or worn. Such teaching is of no help to the present invention in its claimed invention.

Claim 25 was an outcome of the in-person interview of this case on 20 July 2005 wherein the examiner detailed his combination rejection of Praulus and Mertturk and Leifer. This issue has been fully briefed in the parent application sn 09/813103 where the same combination of Praulus and Mertturk was applied. Here, there is a further citation, making it a 3-way combination to make out a prima facie case under sec 103.

In the case of claim 25, the examiner's rejection contains *clear error* because he ignores an element of the claim in his rejection (...pivoting access generally *parallel* to...). Further, the examiner's rejection does not make out a *prima facie rejection* because of the missed element and because the prior art is an opposite teaching. Arguments over these citations were fully briefed before this examiner in a companion case where these references were cited and argued, so the examiner is fully aware the limitations of the cited art. Because that argumentation is not part of this file history, relevant portions are presented below, with adaptation to the present claims:

In the rejection, the Mertturk reference is used in combination with Pralus. Mertturk is a very bare disclosure of a headset with a double-jointed parallel pivot system. It discloses the use of pivots and sliding. It does not render claim 25 obvious. So, the Examiner proposes to combine an element of Pralus into Mertturk. This is an improper application of 35 U.S.C. sec 103 because Pralus is 1) non analogous art (being an over-the-head headset NOT **a unit suspended and supported from an ear**), 2) that nothing in Mertturk would suggest a teaching of combination and indeed its

elemental design teaches away from added complexity of such a combination, and 3) *most* importantly, Pralus simply does not teach the element of **its pivoting axis generally parallel to the longitudinal dimension**. In the present rejection, this issue is completely ignored.

As mentioned above Pralus is non-analogous art. It is an over-the-head unit with a pivoting microphone arm (70) used to allow the unit to be handheld if needed. The problem/solution of Pralus is entirely different to that of the present invention and indeed Mertturk. Why would Mertturk borrow from an over the head system? Pure conjecture. That is not sufficient. 35 U.S.C. sec 103 and indeed MPEP sec. 706.02(j) require much more [..., the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure...]

Further, even if one ignores MPEP sec 706.02(j), the Examiner has still not made a prima facie case. Pralus does **not** pivot have an **unlimited** pivotal axis as asserted by the examiner. Pralus has a limited rotation joint. It pivots in parallel but **not orthogonally** of the longitudinal dimension as required by the claim.

The Examiner has, in the interview, in 09/813103 acknowledged that the pivoting action of microphone arm 18 as shown and described is *circular* and not orthogonal. This is *conclusively* proven by the drawing which shows the *microphone slots always facing inwardly* when the arm is pivoted. Simple geometric analysis shows that the *disclosed* movement is a rotational pivoting movement. Nothing more.

The specification, in column 6, line 16 et seq. states:

It is possible to provide integration of the stem 70 of the microphone with the handset via a ball joint 38, or a flexible stem, that allows articulation of the microphone from one side or the other of the main unit according to where the mouth is

Look closely at the slots on microphone 18. As mentioned, the slots are always facing toward the axis of rotation in the three positions shown in the figure. This is possible **ONLY** if the rotation is around the axis consistent with the figures 1a and 1b which do **NOT** show omni-directional capability.

So why are the arrows in Fig. 2 seemingly suggesting that? Because this is a two dimensional figure and the axis shown in the dotted line is coming out of the paper, in which case, the circular arrows are totally consistent with Figures 1a and 1b.

In summary, Pralus and Mertturk and **incompatible arts**. The Mertturk reference is worn on and supported by the user's ear but its concept is not in agreement with the claimed invention of a pivot which is orthogonal to the longitudinal dimension and parallel to the first surface. Converting Mertturk to agree with the claimed invention would require a massive deviation from its disclosure. The examiner admits that Mertturk's joints are not like those defined in claim 25, then applies Pralus, and completely ignores the requirement for a *pivot orthogonal with respect to the first surface*, as claimed..

Finally, the structure of Pralus does not have the ability of the microphone **contacting** the housing surface (as in claim 25). Because it is on a limited pivot joint, the microphone in Pralus can never contact the housing or it will not be able to freely rotate, as the arrows require. Further, Figure 1a shows that it is **spaced from** the housing, which teaches away from *contacting*, as claimed.

In short, the combination fails for *many* reasons, but one is sufficient to obviate the entire rejection.

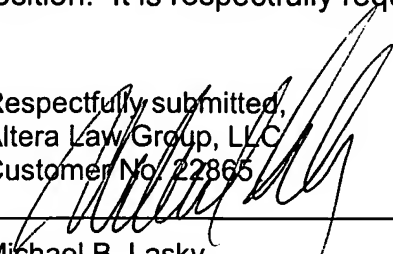
### **Request For Relief**

The relief requested in this case is either 1) the application be granted as is, or 2) an order be made, vacating the rejection but that the case proceed to appeal.

Applicant has no interest in this case being reopened for further prosecution. This case is part of a series of cases which have been prosecuted, continued, and interviewed before the same examiner over a period of years. They are all on or headed for appeal because of clear error and lack of a prima facie case and it is believed that no amount of further prosecution before this examiner will have any impact. Applicants are frankly exhausted by the prosecution in this series of cases but are convinced of the soundness of their position. It is respectfully requested that this case be allowed without further delay.

Date: 17 Apr 06 By: \_\_\_\_\_

Respectfully submitted,  
Altera Law Group, LLC  
Customer No. 22865

  
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